

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1-19, the only claims pending and currently under examination in this application.

FORMAL MATTERS

Claims 1-19 were examined and rejected.

Claims 20-35 have been withdrawn.

No new matter has been added.

REJECTION UNDER 35 U.S.C. § 102(a)

Claims 1-6, 10, 12-14, 18 and 19 have been rejected as being anticipated by Jen et al. (U.S. Patent App. Pub. No. 2004-0266954). The Applicants respectfully traverse the rejection.

According to MPEP 706.02, a rejection based on 35 U.S.C. 102(a) can be overcome by:

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (B) Amending the claims to patentably distinguish over the prior art;
- (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a).**

The Applicants submit herewith a declaration under 37 CFR 1.131. The declaration provides Applicants' invention disclosure as Exhibit A (6 pages). The invention disclosure establishes invention of at least the independent claims of the application prior to the effective date of Jen et al. Therefore, in view of the enclosed declaration under 37 CFR 1.131, Jen et al. cannot preclude the patentability of the rejected claims because Jen et al. does not constitute prior art to the Applicants' claimed invention. Accordingly, this rejection may be withdrawn.

REJECTION UNDER 35 U.S.C. §103(a)

In the Office Action, Claims 1-19 have been rejected under 35 U.S.C. §103(a) as being obvious over Jen et al. (U.S. Patent App. Pub. No. 2004-0266954). The Applicants respectfully traverse this rejection.

With respect to rejections made under 35 U.S.C. § 103, MPEP § 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As set forth above, Jen et al. is not available as prior art in light of the enclosed 1.131 declaration. Because the Office's *prima facie* case of obviousness relies upon Jen et al., the *prima facie* case of obviousness is deficient. Therefore, in view of the disqualification of Jen et al. as prior art, a *prima facie* case of obviousness has not been established. Accordingly, the rejection of Claims 1-19 under 35 U.S.C. § 103(a) may be withdrawn.

In the Office Action, Claims 1-19 have been rejected under 35 U.S.C. §103(a) as being obvious over Jen et al., (U.S. Patent App. Pub. No. 2004-0266954) in view of Small et al. (U.S. Patent No. 6, 271,335). The Applicants respectfully traverse this rejection.

In making the rejection, the Examiner asserts that Jen et al. fails to disclose the "use of bis(furan), tris(furan) or tetrakis(furan) moieties in their reaction" (Final Office Action, p. 5). As such, the Examiner is relying on Small et al. to make up for the deficiency of Jen et al.

However, as noted above, Jen et al. is disqualified as prior art and therefore cannot preclude the patentability of the instant invention.

Without Jen et al., the obviousness rejection is now a rejection solely over Small et al. As Small et al. was cited merely for describing the production of a Diels-Alder reversible resin using various furan compounds, this reference fails to teach or suggest each and every element of the instant invention.

Therefore, the rejection of Claims 1-19 over Jen et al. in view of Small et al. under 35 U.S.C. § 103(a) may be withdrawn because a *prima facie* case of obviousness has not been established for at least the following reasons: (1) the disqualification of Jen et al. as prior art; and (2) the failure of Small et al. to teach or suggest each and every element of the instant invention. Accordingly, this rejection may be withdrawn.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance. Applicants respectfully request withdrawal of the rejections and prompt issuance of a notice of allowance. If the Examiner has any questions concerning this communication or would like to discuss the application, the art or other pertinent matters, a telephone call to the undersigned at (650) 251-7700 would be welcomed.

Respectfully submitted,

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